

REMARKS/ARGUMENTS

A PETITION FOR EXTENSION OF TIME has been filed, concurrently with this Amendment, extending the time for response to the Official Action three (3) months, from November 7, 2006, to February 7, 2007. **The Commissioner for Patents is authorized to credit the Petition fees, namely \$510.00 and any additional fees required, in connection with this Petition, to Deposit Account No. 04-1679.**

As a result of this Amendment, claims 1-3, 5-7, 10-13, and 22-24 are under active consideration in the subject patent application.

In the Official Action, the Examiner has:

(1) acknowledged Applicant's election with traverse of claims in Group I, i.e., claims 1-13 and 22-24, and acknowledged that claims 14-21 have been withdrawn and made the restriction requirement is final;

(2) objected to the drawings under 37 CFR 1.83(a);

(3) rejected claims 9 and 12 under 35 U.S.C. §112, second paragraph;

(4) rejected claims 1-8, 10 and 13 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 2,118,676, issued to Lankton (the "Lankton" reference);

(5) rejected claims 9, 11, 12, and 22-24 under 35 U.S.C. §103(a) in view of the Lankton reference; and

(6) identified prior art made of record and not relied upon but considered pertinent to Applicant's disclosure.

With regard to Item 1, no further comment appears necessary.

With regard to Items 2 and 3, Applicant has canceled claims 8 and 9 thereby removing the basis for the Examiner's objection to the drawings. Applicant requests reconsideration and withdrawal of the objection to the drawings under 37 CFR 1.83(a). Claim 12 has been amended to make clear that it is the scenic silhouettes that are the result of an application of a method selected from the group consisting of: painting, engraving, carving, etching, branding, scoring, embossing, plating, and molding. This limitation may be found in claim 1 as amended and from which antecedent support may be established. Claim 9 is canceled. Reconsideration is requested.

With regard to Items 4 and 5, Applicant traverses the Examiner's reliance upon the disclosures in the Lankton reference, and requests reconsideration and withdrawal of these rejections for the following reasons. Applicant provides a seating unit, such as an Adirondack-style chair, that includes a seat and a back. An upper edge of the back has an aesthetic portion that is one of painted, engraved, carved, etched, branded, scored, embossed, plated, or molded. Advantageously, Applicant's aesthetic portion is patterned to resemble any one of a plurality of preselected existing and naturally occurring scenic silhouettes such as a landscape contour, a ridge profile, or a mountain range.

Claims 1, 11, and 22-24 have been amended to more distinctly define this aspect of Applicant's invention. Support for these changes may be found throughout the specification and drawings as originally filed, and particularly at

pages 7-9. No new matter has been entered into the application as a result of these changes to the claims. No such features are disclosed or suggested by the Lankton reference.

Anticipation under 35 U.S.C. §102 requires that each and every element of the invention defined in the claim be met in a single prior art reference. Those elements must either be inherent or disclosed expressly, and must be arranged as described in the claim. See, Diversitech Corporation v. Century Steps, Inc., 850 F.2d 675, 7 U.S.P.Q.2d 1315 (Fed. Circuit 1988), Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Circuit 1988), and Richardson v. Suzuki Motor Company, 868 F.2d 1226, 9 U.S.P.Q.2d 913 (Fed. Circuit 1989). The Lankton reference utterly fails to teach or suggest an aesthetic portion that is patterned to resemble any one of a plurality of preselected existing and naturally occurring landscape contours, ridge profiles, or mountain ranges.

This structural distinction is quite important, for it reflects a significant difference in both construction and function between Applicant's claimed invention and the device taught in Lankton. More particularly, the Lankton reference is directed to a rocking lawn chair. Figs. 1 and 2 of Lankton show a back rest (17) which consists of a number of boards arranged side by side and secured to one another by a cross cleat (18) where back rest (17) has an arbitrarily cut top end edge (col.2, lines 1-3). In particular, the outermost boards appear to have a concave scallop cut into their respective top edges, while the

interiorly positioned boards have a convex curve cut into their respective top edges. Although these cut edges are shown in Figs. 1 and 2 as joining to form a somewhat aesthetic edge feature, that edge is of an arbitrary form. It does not teach or suggest, in any way, that that top edge should or could be formed as one of a plurality of preselected existing and naturally occurring scenic silhouettes. In fact, Lankton's written specification is utterly silent as to how that edge contour is to be selected or what it might depict, if anything. Lankton's top edge contour appears only to serve an arbitrary aesthetic function, i.e., it is pleasant to look at. In contrast, Applicant's top edge is meant to convey an image of one of a plurality of preselected geographically identifiable scenic silhouettes from nature, e.g., the mountain ridge line in Yosemite Park, California (see Applicant's specification at page 9).

Applicant respectfully submits that the Lankton reference fails to disclose each and every element of the invention as defined by amended claims 1, 11, and 22-24. Reconsideration and withdrawal of the rejection of claims 1-8, 10, and 13 in view of Lankton are requested.

In order for a prima facie case of obviousness to be established, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2142 [emphasis added]. Lankton fails to teach or suggest a back rest in

a sitting device with a top edge having an aesthetic portion that resembles one of a plurality of preselected scenic silhouettes of existing landscape contours, ridge profiles, or mountain ranges. Lankton fails to discuss this aspect of his chair at all! Moreover, Lankton's depiction of an arbitrary aesthetic contour at the top edge of the chair shown in his figures fails to suggest or provide any motivation for the use of an edge contour that resembles or is based upon preselected existing and naturally occurring scenic silhouettes. Lankton simply fails to teach all of Applicant's claim limitations.

Accordingly, claims 1-3, 5-7,10-13, and 22-24 are allowable over Lankton.

In summary, Applicant submits that the unique apparatus defined by claims 1-3, 5-7,10-13, and 22-24 is not disclosed in the prior art reference, taken as a whole, and there is no teaching or suggestion in the reference to support its use by the Examiner. In any event, claims 1-3, 5-7,10-13, and 22-24 are patentable over the Lankton reference.

With regard to Item 7, Applicant has considered the prior art references identified by the Examiner as pertinent and determined that none of them, taken alone, or in any valid combination with the Lankton reference anticipates or renders obvious the present invention.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Appl. No. 10/796,384
Docket No.: E6011-00002
Reply to Office Action of Aug. 7, 2006

If a telephone conference would be of assistance in advancing prosecution of the above-identified application, Applicant's undersigned Attorney invites the Examiner to telephone him at 215-979-1255.

Respectfully submitted,

Dated:01/30/2007

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